

Application of Simon Erani
Serial No. 09/922,233 filed 8/3/2001
Response of 5/17/2007 to Office Action of 11/17/2006

Remarks

Receipt is acknowledged of the Office Action of November 17, 2006. Reconsideration of the application, entry of the enclosed Request for Continued Examination (RCE), and an extension to the present date are hereby requested. The Commissioner is hereby authorized to charge Deposit Account No. 50-1604 for all fees required, and it is requested that any overpayments be credited thereto.

In the Office Action, claims 19-40 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and as presenting new matter on the grounds that the claim language is not supported by the specification. However, it is respectfully noted that that position is inaccurate. The specification as originally filed provides literal support for the terms utilized. The fact that these particular components are utilized, as opposed to other forms of Vitamin A, Vitamin C, etc. is expressly set forth in the first paragraph of the Detailed Description section of the application. *See*, specification p.3, lines 3-5. Accordingly, withdrawal of the written description and new matter rejections is respectfully requested.

With respect to the Office's position that 'comprising' in claim 19 does not exclude the presence of other forms of those vitamins, it is respectfully noted that the Office's reading is not the intended scope of the claim, which was expressly defined on page 8, footnote 1 of applicant's prior response of August 24, 2006. It is also respectfully submitted that the Office's position is also not consistent with the claim language. In brief, the claims recite a composition comprising MDT-5 and then continues to recite that the various vitamins consist of the particular forms recited therein. Thus,

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with respect to the form of Vitamin A, the claim expressly states that it consists of Retinyl Palmitate Polypeptide, which excludes other forms of that vitamin. The consisting of language is likewise recited with respect to the forms of Vitamin C, Vitamin E, Vitamin D, and Vitamin B3.

The use of the term "comprising" in the preamble does not change that. Rather, that open language allows the presence of other compounds in the composition other than the recited MDT-5. For example, the composition could also include glycolic acid. However, with respect to the listed vitamins, the claim is to particular forms "consisting of" the recited compounds, which "consisting of" language excludes others.

With respect to the §103 rejection, reconsideration is requested based on the arguments and evidence set forth below. In particular, various secondary considerations are also relevant to an obviousness rejection and should be given weight in this matter.

Following are the results of searches in the USPTO database for text searchable¹ patents issued as of May 17, 2007 and filed before August 2, 2000². The table shows the queries used and the number of issued patents returned by the database:

¹ It is noted that the publicly accessible PTO database does not provide text searching capability for those patents issued before 1976. See, <http://www.uspto.gov/patft/help/notices.htm> (third paragraph from top) (patents issued from 1790 through 1975 are searchable only by patent number, issue date, and current US classifications). Thus, the results provided below only reflect the last thirty or so years of issued patents.

² The date of August 2 was chosen because it is the day before applicant filed his provisional application. No suggestion is intended herein, however, that such date is dispositive, since questions of obviousness need to be assessed as of the date of applicant's invention, which was before August 2, 2000.

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Search Query	Number of Issued Patents Listed
"vitamin A" and (APD/7/7/1776->8/2/2000)	23524
"vitamin C" and (APD/7/7/1776->8/2/2000)	4746
"vitamin D" and (APD/7/7/1776->8/2/2000)	3738
"vitamin E" and (APD/7/7/1776->8/2/2000)	7676
"vitamin B3" and (APD/7/7/1776->8/2/2000)	77

Although counsel has not reviewed each of those patents (or those in any of the following tables), the above results very roughly show how common it is for those in the art to refer to each of these particular vitamin compositions in issued patents.

Search Query	Number of Issued Patents Listed
("treating skin" or "skin treatment") and "vitamin A" and (APD/7/7/1776->8/2/2000)	1081
("treating skin" or "skin treatment") and "vitamin C" and (APD/7/7/1776->8/2/2000)	335
("treating skin" or "skin treatment") and "vitamin D" and (APD/7/7/1776->8/2/2000)	201
("treating skin" or "skin treatment") and "vitamin E" and (APD/7/7/1776->8/2/2000)	585
("treating skin" or "skin treatment") and "vitamin B3" and (APD/7/7/1776->8/2/2000)	10

Again, while counsel has not reviewed those patents (which could include inventions other than topical applications), the table above roughly shows how commonly those innovating in the art refer to these vitamins wherein the disclosure includes the terms "treating skin" or "skin treatment".

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Search Query	Number of Issued Patents Listed
("Retinyl Palmitate Polypeptide" or "Vitamin A polypeptide" or "Vitazyme A-Plus") and (APD/7/7/1776->8/2/2000)	8
("Ascorbylmethylsilanol Pectinate" or Ascorbosilane or "Methylsilanol Ascorbate") and (APD/7/7/1776->8/2/2000)	4
("Tocopheryl Polypeptide" or "Vitamin E polypeptide" or "Vitazyme E") and (APD/7/7/1776->8/2/2000)	1
("Cholecalciferol Polypeptide" or "Vitamin D Polypeptide" or "Vitazyme D") and (APD/7/7/1776->8/2/2000)	3
("Niacinamide Polypeptide" or "Vitamin B3 polypeptide" or "Vitazyme B3") and (APD/7/7/1776->8/2/2000)	0

Search Query	Number of Issued Patents Listed
("treating skin" or "skin treatment") and ("Retinyl Palmitate Polypeptide" or "Vitamin A polypeptide" or "Vitazyme A-Plus") and (APD/7/7/1776->8/2/2000)	3
("treating skin" or "skin treatment") and ("Ascorbylmethylsilanol Pectinate" or Ascorbosilane or "Methylsilanol Ascorbate") and (APD/7/7/1776->8/2/2000)	2
("treating skin" or "skin treatment") and ("Tocopheryl Polypeptide" or "Vitamin E polypeptide" or "Vitazyme E") and (APD/7/7/1776->8/2/2000)	0
("treating skin" or "skin treatment") and ("Cholecalciferol Polypeptide" or "Vitamin D Polypeptide" or "Vitazyme D") and (APD/7/7/1776->8/2/2000)	0

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("treating skin" or "skin treatment") and ("Niacinamide Polypeptide" or "Vitamin B3 polypeptide" or "Vitazyme B3") and (APD/7/7/1776->8/2/2000)	0
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The two tables above show further comparative results with respect to the components of applicant's claimed composition.

In other words, the PTO's databasc clearly shows that prior art viewed as a whole would lead one of ordinary skill away from applicant's approach and his claimed inventions. It was fairly common for vitamins A, C, D, and E to be referred to in U.S. patents having disclosure including the terms "treating skin" or "skin treatment". But it was rare for the compounds of applicant's combination to be relied on or discussed by those engaged in innovation. The patents show this whether in association with the particular search terms used for treating skin, or in any other context. Applicant's approach or combination is not one that could have been expected in the art when viewed as a whole.

Furthermore, in addition to the arguments previously set forth with respect to the particular form of Vitamin C that applicant uses, it is noted that the above tables also show that applicant's use of his particular form of Vitamin B3 is also not an approach expected in the art.

There is a widespread desire in the art for improved skin care compositions, resulting in extensive research in this field around the world every year. Considering the millions or billions of dollars spent on research in this area, the results above show in a very objective sense that the very

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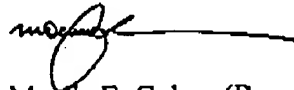
many researchers who are in this field have not seen fit to proceed in applicant's direction toward the claimed inventions, or in any direction even comparable.

It is submitted that this evidence presented, which relates to long felt need, failure by others, and/or to the approaches of others in the art, is extremely relevant. It clearly demonstrates that Applicant's approach was an uncommon one, off the beaten path, constituting non-obvious invention.

Accordingly, reconsideration of the rejections and favorable action on the application is respectfully requested.

Dated: May 17, 2007

Respectfully submitted,



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